

REMARKS

On March 14, 2006, the Examiner objected to Figures 1-5 under 37 C.F.R. § 1.121(d) as needing to be designated by a legend. Applicant has enclosed five (5) sheets of corrected drawings. The Examiner also rejected Claims 6-12 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the present invention. Claims 1, 2 and 7-15 were rejected under 35 U.S.C. § 102(b) as being anticipated by Reynolds and as being anticipated by Fraser. The Examiner rejected Claim 2 as being obvious over Fraser in view of Applicant's Admitted Prior Art ("AAPA"), rejected Claim 6 as being obvious over Reynolds in view of Waring, rejected Claims 7 and 8 as being obvious in view of Fraser and Dupree, and also rejected Claims 1, 2 and 7-15 as being obvious over AAPA in view of Reynolds.

In response, Applicant has amended Claims 1 and 13 to include the limitations of Claims 7 and 8, amended dependent Claims 6 and 9-12 to comply with § 112 and canceled Claims 7 and 8. Applicant has amended independent Claims 1 and 13 to more clearly distinguish them from Reynolds and Fraser, and as such, Applicant believes that nothing in the prior art when taken singularly or when combined teach or suggest the present invention as disclosed in the amended claims.

It should first be noted that it is well known to those skilled in the aircraft industry that when an aircraft turbo charger has a crack, erosion or broken areas, the turbo charger is discarded and destroyed. Those skilled in the art will appreciate that they are not repaired for reuse. The Applicant has performed the required, proper testing, and aircraft engineers agree that a repair made pursuant to the method disclosed in the present invention is a good repair and should be approved by for use on airplanes. The process disclosed in the present invention is awaiting FAA approval.

Claim 6 of the present invention teaches peening of the part and the weld with a needle scaler in order to relieve stress. The Examiner is correct in that Waring discloses peening of the weld deposits on crack sensitive areas. However, it should be noted that Waring actually teaches away from the present invention. Column 6, lines 50-51 in Waring states “[p]eening of the base material and the final weld layer is to be avoided.” That is exactly what the applicant is doing in the present invention. The present invention uses peening on the final weld layers and adjacent base metal of the part or assembly in order to eliminate stress build up. In addition, Waring uses an air hammer to peen, which is different from a needle scaler. Applicant has amended Claim 6 to clearly point out this distinction.

Regarding Claim 1, Applicant has amended it to be limited to an engine part or accessory that has a tubular portion, and is thus distinguishable from both Reynolds and Frasier. Reynolds is directed toward repairing gasket surfaces, alignment rings, flanges and seal bores, whereas Frasier is directed toward repairing turbine blades. As amended, the present invention is clearly distinguishable from both the Reynolds and Frasier repair processes.

In addition, Applicant has amended Claim 1 to include the limitations of Claims 7 and 8, and as such, the present invention is clearly distinguishable from the cited prior art. The Examiner cites Dupree in combination with Frasier against Applicant. Dupree involves a method of repair using a tapered plug to fill an opening. In Dupree, the opening is created in the location of the crack and is then fitted with a tapered plug. This tapered plug is secured with bonding material. The plug is finally polished so that its outer surface is level with that of the article being repaired. This is significantly different than the process of the present invention. In the present invention, the opening is created in the tubular portion of the part in order to gain access to the interior for repairs.

The repairs are actually performed on the interior portion of the part. This process disclosed in the present invention differs greatly from Dupree, wherein none of the repairs are performed on the interior portion of the part or article. Applicant believes the amended claims clearly distinguish these differences.

Furthermore, the Examiner mistakenly cites Reynolds seal bore 16 (Figures 6 and 7) as being tubular. Seal bore 16 in the Reynolds patent is an opening which is “substantially cylindrical and is concentric with the seal surface and alignment ring.” Column 3, line 5-6. In addition, the seal bore is complete distinguishable from a turbo exhaust housing. Reynolds discloses filling the seal bore with weld material in excess of the original and finished dimensions. The weld material is then machined down to the finished dimensions. In the present invention, the tubular portion is a turbo exhaust housing or other similar part or assembly. An opening is made into the side of the tubular portion in order to gain access to the interior for repairs. The tubular portion in the present invention is not completely filled with weld material; the tubular portion is accessed only to repair internal cracks, erosion and broken areas. As such, the process set forth in the present invention is clearly distinguishable and different from Reynolds and the other cited prior art.

Finally, it is improper to combine references to achieve the invention under consideration unless there is some teaching, incentive or suggestion in the references to do so.

It has been repeatedly held that under 35. U.S.C. § 103 the examiner is expected to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary

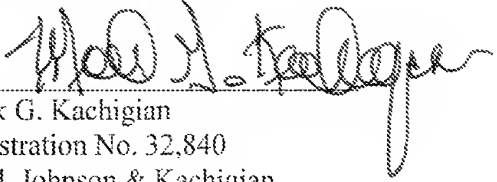
skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Consequently, “obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor.” Para-Ordnance Mfg. V. SGS Importers Int’l, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995) (citing W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983)). “It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (citing In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991)).

In the present invention, there is no teaching, suggestion or incentive in the references to combine the teachings of Reynolds, Waring, Frasier or Dupree. The Examiner is required to follow the law as set forth by the Federal Circuit. The combination of patents to achieve the claims of the present invention is untenable, and thus the Examiner has failed to establish a prima facie case of obviousness.

It is believed that the foregoing is fully responsive to the outstanding Office Action, and for all the above stated reasons, Applicant believes that the application should be in condition for allowance and such action is earnestly solicited.

If, for some reason, any other issues remain, a telephone conference with the Examiner is respectfully requested.

Respectfully Submitted

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